

REMARKS

Claims 1-10 and 12-23 are pending in the subject application. After entry of the above amendments, claims 19 and 23 have been amended. The Examiner is respectfully requested to reconsider the rejection of the claims in view of the remarks as set forth herein below.

Applicant respectfully requests the Examiner to enter the above amendments to the claims, since these amendments do not require further consideration and/or search by the Examiner. Specifically, the amendment to claim 19 is being made to overcome the rejection of claims 19 and 20 under 35 U.S.C. § 112, 2nd paragraph and the amendment to claim 23 is being made to overcome the objection to the Drawings under 37 C.F.R. § 1.83(a) and the rejection of claim 23 under 35 U.S.C. § 112, first paragraph, and place these claims in condition for allowance or in better condition for appeal.

1. The drawings stand objected to under 37 C.F.R. § 1.83(a). This rejection is respectfully traversed.

Claim 1 recites "said cooler chest having a substantially rectangular parallelepiped configuration". The embodiments shown in Figures 1-7 and the embodiment shown in Figure 8 both include a cooler chest having a substantially rectangular parallelepiped configuration. Specifically, as can be seen from Figure 3, the top planar view is substantially rectangular shaped and the side elevational view shown in Figure 2 is also substantially rectangular shaped resulting in a substantially rectangular parallelepiped configuration.

According to the present invention, it is “desirable to provide a substantially rectangular parallelepiped configuration of the cooler chest and lid to maximize the space and utility of the cooling compartment.” (See page 4, lines 19-23 of original specification) Thus, in the embodiment of the cooler according to the present invention shown in Figures 1-7 the motor vehicle is exaggerated in the height direction to accommodate the height required for providing a usable size cooler. Alternatively, in the embodiment of the cooler according to the present invention shown in Figure 8, a lower portion of the cooler chest is configured to simulate a motor vehicle to scale while the upper portion of the cooler chest remains substantially generic (i.e. no specialized design).” (See page 4, lines 23-25) Thus, the specification clearly sets forth that both the embodiment shown in Figures 1-7 and the embodiment shown in Figure 8 have a “substantially rectangular parallelepiped configuration.”

Further, the specification discloses that “the lower cooler chest 12 is a substantially rectangular parallelepiped.” (See page 8, lines 18-19). This disclosure is directed to the embodiments shown in Figures 1-7. Thus, applicant clearly sets forth the definition and meaning of the phrase “substantially rectangular parallelepiped” and the importance of this feature in the originally filed specification.

Regarding the hood and trunk as a closure for a parallelepiped shaped cooler device of claims 12, and 14-17, again the language of claim 1 applies to the embodiment shown in Figures 1-7, and thus the features of claims 12 and 14-17 also apply to that particular embodiment and are proper.

Regarding the exaggerated features of claims 22 and 23, again the language of claim 1 applies to the embodiment shown in Figures 1-7 and claims 22 and 23 are directed to the same embodiment and are proper.

Regarding the handle portion connected to the lid of claim 23, claim 23 has been amended to delete the particular language relating to the handle being connected to the hood.

2. Claim 23 stands rejected under 35 U.S.C. § 112, first paragraph "as failing to comply with the written description requirement." This rejection is respectfully traversed.

Claim 23 has been amended in response thereto.

3. Claims 19 and 20 stand rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

Claims 19 and 20 have been amended in response thereto.

4. Claims 1-8, 10, 12-19, 21 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moffett, III et al. (U.S. DE 414,987) in view of Hartman (U.S. DE 362,788). This rejection is respectfully traversed.

Moffett, III *et al.* discloses a combined cooler and stereo. The Examiner states that "Moffett discloses a portable cooler chest with a parallelepiped configuration and at least one storage compartment with an opening, a lid, and at least one pair of wheels (see Figure 1)." It is noted that the set of protrusions extending downwardly from the chest on the right side in Figure 4 and shown in Figure 2 do not appear to be wheels, since the fasteners or supports for these protrusions do not extend down far enough to support a functioning axle. The Examiner notes that "Moffett lacks, or does not expressly disclose, operational wheels or the chest and wheels configured to visually simulate a motor vehicle."

The Examiner states it "would have been obvious to one of ordinary skill in the art at the time invention was made to provide the wheels of Moffett as operational in order to enable easy transport of the cooler." It is noted that the drawings of Moffett may suggest a single pair of wheels on the bottom left side (Figure 4) of the chest, however, the protrusions on the right side of the chest (Figure 4) do not suggest a set of wheels as previously explained. Further the cooler chest of Moffett does not visually simulate a motor vehicle. Thus, Moffett alone does not teach or suggest the claimed combination.

Hartman discloses a combined cooler and picnic supply holder. The drawings of Hartman clearly show that the cooler chest does not have a "substantially parallelepiped" configuration according to the claimed combination. Specifically, the cooler chest of Hartman is a substantially much more complex shape having an upper front edge portion located at one height (i.e. to accommodate the hood) and a back edge portion located at a different and greater

height (i.e. to accommodate the roof) dictated by the configuration of the car being visually simulated.

The Examiner states that as “to the visual simulation, Hartman discloses that it was well known in the art at the time the invention was made to alter the shape of a cooler into the shape of a car”, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shape of the cooler of Moffett to simulate a motor vehicle as suggested by Hartman, in order to visually appeal to car enthusiasts. Such a modification would entail a mere change in shape. A change in form or shape is generally recognized as being within a level of ordinary skill in the art, absent any showing of unexpected results.”

The cooler of Hartman does not have a substantially rectangular parallelepiped configuration according to the claimed combination. To apply the teaching of Hartman (e.g. complex motor vehicle configuration) to the cooler disclosed by Moffett, III *et al.* does not result in the claimed combination (i.e. cooler chest having a substantially parallelepiped configuration and configured to visually simulate a motor vehicle), and is not suggested. Specifically, the configuration of the car visually simulated by Hartman absolutely requires that the hood portion be located at a different height below that of the roof portion of the cooler chest. To raise the hood portion of the cooler chest to that of the roof portion of the chest would destroy the configuration of the vehicle of Hartman, and is clearly not suggested. This would result in a box-shaped cooler having some semblance or impression of a motor vehicle, however, looking substantially unlike a recognizable motor vehicle, and again is not suggested. To destroy the intended configuration of the cooler of Hartman to the extent suggested by the Examiner is based

on improper hindsight relying on applicant's disclosure and claimed invention to make such a modification plausible. Specifically, it is applicant's invention to configure a substantially parallelepiped cooler chest to also visually simulate a motor vehicle (e.g. by exaggerating the height of the motor vehicle (Figures 1-7) or making only a lower portion of the cooler chest a scale motor vehicle (Figure 8).

More specifically, in the presently claimed invention, it is required and claimed that the cooler chest have a substantially rectangular parallelepiped configuration while also visually simulating a motor vehicle. This combination is not taught or suggested by the prior art cited and disclosed by Moffett, III *et al.* and Hartman. The particular configuration of the visually simulated motor vehicle shown by Hartman does not allow or lend itself to such a modification as proposed by the Examiner. In the presently claimed invention, a cooler chest having a substantially rectangular parallelepiped configuration in combination with visually simulating a motor vehicle can be achieved, for example, by exaggerating one or more features (e.g. height dimension, Figures 1-7) of the cooler chest itself to achieve the substantially rectangular parallelepiped configuration, or by only making a lower portion (Figure 8) of the substantially parallelepiped cooler chest configured to visually simulate a scale motor vehicle. Moffett, III *et al.* and/or Hartman do not teach or suggest either method or means to simulate a motor vehicle with a substantially rectangular parallelepiped cooler chest. In conclusion, Moffett, III *et al.* and/or Hartman alone or in combination do not teach or suggest the claimed invention.

The Examiner cites *In re Daley et al.*, 149 USPQ 47 to teach a "change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results", and cites *In re Seid*, 73 USPQ 431 as teaching "a change in aesthetic (ornamental) design generally will not support patentability."

In the case of *In re Daley et al.*, a change in shape to the lower portion of the baby bottle to be slightly different (i.e. slight design change only) from that of the prior art does not support patentability for utility type claims. This particular change had no functional purpose as far as changing the functioning and performance of the lower portion of the baby bottle, and was simply an ornamental change only in a failed attempt to gain patentability in a utility application.

In the case of *In re Seid*, the shape of the container was changed in only an ornamental manner with no change as to the functioning or performance of the bottle. Thus, in both of these cases, the claim language was directed to or associated with the change of only an ornamental feature without any change to the functionality or performance of the object, namely a baby bottle and a container. In the present case, the substantially rectangular parallelepiped configuration of the cooler chest is mentioned in the originally filed specification as being a desirable and important aspect or feature of the present invention in both the section titled Summary Of The Invention and in the section titled Detailed Disclosure of Preferred Embodiments of the invention with respect to the claimed combination. The substantially rectangular parallelepiped configuration of the cooler chest significantly changes the functionality and performance of the cooler chest of that shown by Hartman, in that the front portion of the cooler chest of Hartman is not substantially rectangular (see Figures 3 and 4) and short in height

making it difficult to store items or significantly decreasing the amount of items that can be stored in the front portion of the cooler and decreasing the performance thereof. Further, the cooler chest of Hartman also requires two separate lid portions, including a front hood portion and a back roof portion due to the different heights of the front cooler chest portion and the back cooler chest portion. Thus, the configuration disclosed by Hartman is somewhat awkward and impractical versus a substantially parallelepiped cooler chest, and not optimized to function as a usable cooler.

Thus, the substantially rectangular parallelepiped configuration of the cooler chest according the claimed combination significantly changes the functionality and increases the performance of the cooler chest over the cited prior art, resulting in a cooler device according the claimed invention unlike the objects or devices discussed in the case of *In re Daley et al.* and *In re Seid*. Specifically, these cases are not on point and deal with claiming strictly ornamental features with utility type claims unlike the current situation.

Moffett, III *et al.* does disclose a substantially rectangular parallelepiped type configuration of the cooler chest, but the teaching of Hartman does not suggest modifying the particular configuration of the vehicle visually simulated by Hartman to the cooler chest of Moffett, III *et al.* In fact, such a modification is not suggested, since it would destroy the configuration of the vehicle visually simulated in Hartman when attempting to do so in the substantially rectangular parallelepiped configuration of Moffett, III *et al.* It so happens factually that the particular configuration of the car selected by Hartman does not lend itself to such a modification, for example, by exaggerating the height dimension of the front portion of the

cooler of Hartman. In the present invention, a particular type of motor vehicle having a particular configuration must be first selected so that it can then be modified (e.g. exaggerating in height feature) to make a substantially rectangular parallelepiped configuration of the cooler chest while simulating the look and appearance of a motor vehicle so as to be immediately recognized as a simulated motor vehicle to achieve the desired results of the claimed invention.

5. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moffett, III et al. and Hartman as applied to claim 1 above and further in view of Teel (U.S. 6,076,298). This rejection is respectfully traversed.

Teel is cited by the Examiner and for the purpose of disclosing wheel wells. However, Teel adds no relevant teaching with respect to the base claim combination including a cooler chest having a substantially rectangular parallelepiped configuration and configured to visually simulate a motor vehicle. Thus, Moffett, III et al., Hartman and/or Teel alone or in combination do not teach or suggest the claimed invention.

6. Claims 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moffett, III et al. and Hartman as applied to claim 1 above, and further in view of Wilson (U.S. 6,264,216). This rejection is respectfully traversed.

Wilson is cited by the Examiner for the purpose of disclosing a trailer attachment 14. However, Wilson does not add any relevant teaching with respect to the base claim combination including a cooler chest having a substantially rectangular parallelepiped configuration and

configured to visually simulate a motor vehicle. Thus, Moffett, III *et al.*, Hartman and/or Wilson alone or in combination do not teach or suggest the claimed invention.

7. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moffett, III *et al.* and Hartman as applied to claims 13-17 above, and further in view of Arel *et al.* (U.S. 3,081,394). This rejection is respectfully traversed.

Arel is cited by the Examiner for the purpose of disclosing a handle 20 attached to a lid such that the lid 2 pivots open upon pressing down upon handle 20. However, Arel *et al.* does not add any relevant teaching with respect to the base claim combination including a cooler chest having a substantially rectangular parallelepiped configuration and configured to visually simulate a motor vehicle. Thus, Moffett, III *et al.*, Hartman and/or Arel alone or in combination do not teach or suggest the claimed invention.

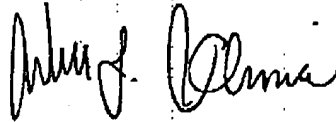
In view of the above amendment and remarks, it is believed that the claims are in condition for allowance and allowance is respectfully requested.

It is not believed that extensions of time are required beyond those that my otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are necessary and hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account No. 11-1243.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 11-1243.

Respectfully submitted,

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Date: January 26, 2005

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